

JUN. 5. 2006 1:04PM

(3) FISH & RICHARDSON 6175428906

NO. 0824 P. 1/5

## FISH & RICHARDSON P.C.

225 Franklin Street  
Boston, Massachusetts  
02110-2804

Telephone  
617 542-5070

Facsimile  
617 542-8906

Web Site  
[www.fr.com](http://www.fr.com)

Date June 5, 2006

To Examiner Duane Bost  
U.S. Patent and Trademark Office

Telephone: (571) 272-7023

Facsimile number 01997-25300005 / (571) 273-7023

From Maureen Christiano  
Secretary to G. Roger Lee

Re USSN 09/335,376  
Our Ref.: 01997-253005

Number of pages  
including this page 5

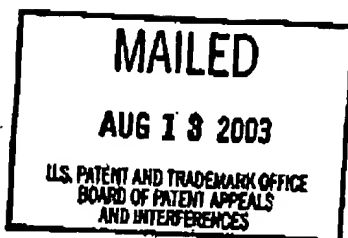
Message In accordance with your request, attached is a copy of the Remand to the Examiner.

NOTE: This facsimile is intended for the addressee only and may contain privileged or confidential information. If you have received this facsimile in error, please immediately call us collect at 617 542-5070 to arrange for its return. Thank you.

01717/253005 FRD  
GRL

The remand being entered today was not written  
for publication and is not binding precedent of the Board.

Paper No. 23

**UNITED STATES PATENT AND TRADEMARK OFFICE****BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**Ex parte JAE S. LIMAppeal No. 2003-1864  
Application No. 09/335,376<sup>1</sup>**REMAND TO EXAMINER**

Before STONER, Chief Administrative Patent Judge, HARKCOM, Vice Chief  
Administrative Patent Judge, and NASE, Administrative Patent Judge.

Per curiam.**REMAND TO THE EXAMINER**

The above-identified application is being remanded to the examiner for  
appropriate action.

<sup>1</sup> Application filed June 17, 1999, for reissue of U.S. Patent No. 5,640,486 (Application No. 08/345,879, filed November 28, 1994).

* No Docketing Required *
Reviewed By Practice Systems
Initials: <i>JMG</i>
Reviewed By Billing Secretary

Appeal No. 2003-1864  
Application No. 09/335,376

Page 2

### BACKGROUND

1. A review of the file record indicates that claims 9, 11-16, 18-21, 23, 28-35, 37-50, 54, 55, 57-64, 66-72, 74-77, 79-81, 85-88, 96, 97, 99-102, 106-109, 116-120, 122-126, 128-131, 133-137 and 139-153 have been rejected under 35 U.S.C. § 251 as attempting to recapture subject matter surrendered in the application to obtain the original patent.

2. A precedential opinion concerning a reissue recapture rejection under 35 U.S.C. § 251 was decided May 29, 2003 in Ex parte Eggert.<sup>2</sup> In Eggert, the majority opinion applied the fact-specific analysis set forth in In re Clement, 131 F.3d 1464, 1468-71 45 USPQ2d 1161, 1164-66 (Fed. Cir. 1997), determined that under the facts and circumstances before it, the "surrendered subject matter" was claim 1 of Eggert as that claim existed prior to the post-final rejection amendment that led to the allowance of claim 1 in the original patent, and decided that reissue claims 15-22 of Eggert were not precluded (i.e., barred) by the "recapture rule." Slip. op. at 39-45.

### ACTION

We remand this application to the examiner for a determination of whether the rejection under 35 U.S.C. § 251 remains appropriate in view of Ex parte Eggert.

If the examiner determines that the rejection under 35 U.S.C. § 251 remains appropriate, the examiner is authorized to prepare a supplemental examiner's answer

---

<sup>2</sup> A copy of the Eggert opinion is attached to this opinion. An electronic copy of Eggert is available at <http://www.uspto.gov/web/offices/dcom/bpai/prec/RC010790.pdf>.

Appeal No. 2003-1864  
Application No. 09/335,376

Page 3


specifically addressing the § 251 rejection. See 37 CFR § 1.193(b)(1). In the event that the examiner furnishes a supplemental answer, the appellant may file a reply brief in accordance with 37 CFR § 1.193(b)(1).

**If the examiner determines that the rejection under 35 U.S.C. § 251 is no longer appropriate, the examiner should withdraw the rejection in an appropriate Office action.**


## CONCLUSION

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01.

If after action by the examiner in response to this remand there still remains decision(s) of the examiner being appealed, the application should be promptly returned to the Board of Patent Appeals and Interferences.

  
BRUCE H. STONER, JR.  
Chief Administrative Patent Judge

*Gary V. Harkcom*  
GARY V. HARKCOM  
Vice Chief Administrative Patent Judge

  
JEFFREY V. NASE  
Administrative Patent Judge

BOARD OF PATENT  
APPEALS  
AND  
INTERFERENCES

JUN. 5. 2006 1:05PM

(3) FISH & RICHARDSON 6175428906

NO. 0824 P. 5/5 —▲——

Appeal No. 2003-1864  
Application No. 09/335,376

Page 4

FISH & RICHARDSON PC  
225 FRANKLIN ST  
BOSTON, MA 02110